

REMARKS

Claims 1-39 are pending in the current application. Applicant has amended claims 1, 14, 16, and 27 and added claims 40 and 41. Reexamination and reconsideration of all of the claims are respectfully requested.

§ 103

The Examiner rejected claims 1-39 under 35 U.S.C. § 103 based on de Groot, USP 6,249,351 (“the de Groot reference”) in combination with Holly ‘830 (“Holly”).

Applicants have amended the “predetermined standardized characteristics” language in independent claims 1, 16, and 27 to recite “said predetermined standardized characteristics comprising a set of physical attributes varying between specific sections on the specimen surface” (claim 1), “said predetermined standardized characteristics comprise known physical variations between sections on the specimen surface” (claim 16), and “said predetermined standardized characteristics comprising at least one from a group comprising surface pitch variations, wire density variations, linewidth variations, and line space variations” (claim 27). None of these predetermined standardized characteristics, particularly characteristics comprising “a set of physical attributes varying between sections on the specimen surface,” “known physical variations between sections on the specimen surface,” or “at least one from a group comprising surface pitch variations, wire density variations, linewidth variations, and line space variations,” are suggested or disclosed by the de Groot reference. The de Groot reference does not mention CMP wafers or the issues associated therewith, and teaches no inspection of a specimen having predetermined standardized characteristics thereon as claimed in independent claims 1, 16, and 27, as amended. Applicants contend that the de Groot reference in pertinent part discusses full inspection of the entire wafer surface, without mention of or inspection of predetermined standardized characteristics on the wafer surface. Absence of this “predetermined standardized characteristic” aspect of the claims renders independent claims 1, 16, and 27, and claims dependent thereon, allowable over the de Groot reference.

Further, noting the absence from de Groot of the ability to inspect less than the entirety of the wafer, the Office Action relies on Holly in rejecting all claims for, *inter alia*, the limitation of “passing light energy only over a portion of the specimen surface having predetermined standardized characteristics, said portion comprising less than half of the specimen surface,” and other independent claim limitations regarding scanning less than the entirety of the specimen surface. Applicants dispute that there is any motivation in the de Groot reference to combine the reference with Holly, or any motivation in Holly to combine the design with the de Groot reference as is being done in the Office Action. de Groot does not disclose inspecting less than the entirety of the surface, and Holly does not employ the diffraction gratings, reflective surfaces, collimators, and other aspects of the current claims in the Holly design. The Holly design operates in a completely different manner, using a Bragg cell, beam width adjuster and convex lens to allegedly sense defects on a surface. Applicants contend that it is only by using hindsight that the Applicants’ invention can be constructed from a combination of the de Groot and Holly references.

The Federal Circuit has held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital System, Inc. v. Montefiore Hospital*, 732 F.2d 1572 (Fed. Cir. 1984). Without some showing in the prior art that suggests in some way a combination in order to arrive at the claimed invention, it is impermissible to use the Applicant’s teaching to search references for the claimed elements and combine them as claimed. *In Re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); *In Re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989); *see also, Ex Parte Lange*, 72 U.S.P.Q. 90, 91 (C.C.P.A. 1947) (“It seems to us that the Examiner is using appellant's disclosure for the suggestion of the combination since there is no suggestion in any of the patents for their combination in the manner claimed by Applicant.”); *In re Leonor*, 158 U.S.P.Q. 20, 21 (C.C.P.A. 1968) (the issue is “whether teachings of prior art would, of themselves, and without benefit of applicant's disclosure, suggest [a process] which would make claimed invention obvious...” (emphasis in original)). The de Groot reference does not suggest

combining the reference with Holly to produce the unique system claimed in Applicants' claim 1.

Applicants respectfully submit that the Office Action uses hindsight in rejecting the claims herein. It is only through hindsight, after seeing Applicants' disclosure, that it would be considered possible to create the system for scanning a portion of the specimen surface in the manner claimed by the Applicants. With regard to the use of hindsight, or the use of the Applicant's teaching to combine references, the courts have universally condemned such combinations and have upheld the validity of patents or claims of patents in which such hindsight was employed to combine the references. *W.L. Gore Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983), (condemning the "insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher"); *In re Fine*, 837 F.2d 1044, 1051 (Fed. Cir. 1988) ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.") Applicant respectfully submits that combination of aspects of the de Groot reference with aspects of the Holly design is merely a hindsight reconstruction of the invention. Such hindsight reconstruction of the claimed system is inappropriate and thus rejection of claims 1, 16, and 27 and claims dependent thereon for this reason is improper.

All claims dependent from these allowable independent claims 1, 16, and 27 are allowable as they depend from an allowable base claim. Accordingly, it is respectfully submitted that all claims fully comply with 35 U.S.C. §103.

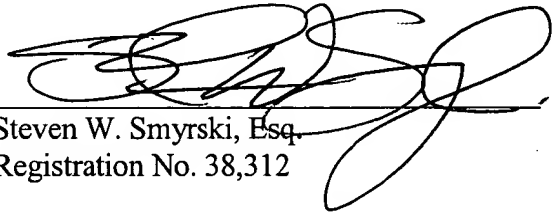
CONCLUSION

In view of the foregoing, it is respectfully submitted that all claims of the present application are in condition for allowance. Reexamination and reconsideration of all of the claims, as amended, are respectfully requested and allowance of all the claims at an early date is solicited.

Applicant believes that no fees are due in accordance with this Response beyond those included herewith. Should any fees be due, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment to Deposit Account 502026.

Respectfully submitted,

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